

REMARKS / ARGUMENTS

Claims 42-59 and 90-93 are pending in this application. By this Amendment, Applicant AMENDS claims 42 and 57.

The Examiner is reminded that in an Information Disclosure Statement filed on August 3, 2007, Applicant cited copending U.S. Patent Application Nos. 11/718,646; 10/972,168; 11/718,651; 11/749,953; and 11/749,958 to bring to the attention of the Examiner and have the Examiner consider the subject matter and claims of the copending U.S. Patent Application(s), the prior art references, Office Actions and responses to Office Actions made of record in the copending U.S. Patent Application(s). The Examiner is respectfully requested to update his/her review and consideration of the claims of the copending U.S. Patent Application(s), the prior art references, Office Actions and responses to Office Actions made of record in the copending U.S. Patent Application(s).

Claims 42-53 were rejected under 35 U.S.C. § 102(b) as being anticipated by Longobardi et al. (U.S. 5,106,126). Claims 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Longobardi et al. Claims 56-59 and 90-93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Longobardi et al. in view of Mori et al. (U.S. 4,603,065).

Applicant respectfully traverses the rejections of claims 42-59 and 90-93.

Claim 42 has been amended to recite:

A decorative sheet comprising:
a deformable base member having first and second principal surfaces opposed to each other;
a continuous decoration layer provided directly on the first principal surface of the base member and having a pattern area representing a predetermined pattern, the decoration layer being defined by an ink layer that is visible from a direction perpendicular to a plane including the ink layer; and
a spread suppressing member provided at a location corresponding to the pattern area on the side of the second principal surface of the base member, for suppressing the spreading of the pattern area; wherein
the spread suppressing member is arranged so as to cover only a

portion of the base member and is made of a material that suppresses the spreading of the pattern area of the decoration layer. (emphasis added)

Applicant's claim 57 recites features that are similar to the features recited in Applicant's claim 42, including the above-emphasized features.

The Examiner alleged that Longobardi et al. teaches a transparent plastic resin 12 (the alleged deformable base member), an ink image 12 (the alleged continuous decoration layer), and a reflective metal 30 (the alleged spread suppressing member) around all surfaces of the ink image 24 except for the surface of the ink that touches the transparent plastic resin 12.

Applicant has amended claims 42 and 57 to recite the feature of "a spread suppressing member provided at a location corresponding to the pattern area on the side of the second principal surface of the base member, for suppressing the spreading of the pattern area." Support for this feature is found, for example, in the first full paragraph on page 17 of Applicant's substitute specification and in Figs. 1(a) and 3 of Applicant's originally filed drawings.

In contrast, Longobardi et al. teaches that the reflective metal 30 is provided on the first principal surface of the transparent plastic resin 12, that is, on the same side of the transparent plastic resin 12 as the ink image 24 (see, for example, column 3, lines 3-8 and 63-68; column 4, lines 3-5; and Figs. 3 and 4 of Longobardi et al.). Longobardi et al. does not teach or suggest that the reflective metal 30 may be provided on the second principal surface of the transparent plastic resin 12, that is, on the opposite side of the transparent plastic resin 12 from the ink image 24.

The Examiner is reminded that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Furthermore, since the reflective metal 30 of Longobardi et al. is provided to give the image a shiny, metallic appearance, there would have been no proper motivation to modify the decorative sheet of Longobardi et al. such that the reflective metal 30 is

provided on the second principal surface of the transparent plastic resin 12, because (1) such a modification would not give the image a shiny, metallic appearance, and (2) the metal layer 30 would cover up and obscure the view of the ink image 24 (see, for example, column 1, lines 51-57 and column 2, lines 29-33 of Longobardi et al.).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 42 under 35 U.S.C. § 102(b) as being anticipated by Longobardi et al.

The Examiner relied upon Mori et al. to allegedly cure the deficiencies of Longobardi et al. However, Mori et al. clearly fails to teach or suggest the feature of "a spread suppressing member provided at a location corresponding to the pattern area on the side of the second principal surface of the base member, for suppressing the spreading of the pattern area," as recited in Applicant's claim 57. Thus, Applicant respectfully submits that Mori et al. fails to cure the deficiencies of Longobardi et al. described above.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Longobardi et al. in view of Mori et al.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 42 and 57 are allowable. Claims 43-56, 58, 59, and 90-93 depend upon claims 42 and 57, and are therefore allowable for at least the reasons that claims 42 and 57 are allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Dated: October 29, 2007

/Stephen R. Funk #57,751/
Attorneys for Applicant

KEATING & BENNETT, LLP
8180 Greensboro Drive, Suite 850
Tyson's Corner, VA 22102
Telephone: (703) 637-1480
Facsimile: (703) 637-1499

Joseph R. Keating
Registration No. 37,368

Stephen R. Funk
Registration No. 57,751